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| APPLICATION NUMBER | FILING DATE | GRP ART UNIT | FIL FEE REC'D | ATTY. DOCKET NO. | DRAWINGS | TOT CLAIMS | IND CLAIMS |
|--------------------|-------------|--------------|---------------|------------------|----------|------------|------------|
| 09/990,099         | 11/21/2001  | 1645         | 0.00          | P0012US20        | 4        | 76         | 7          |

CONFIRMATION NO. 1291

29490  
GENOMICS INSTITUTE  
OF THE NOVARTIS RESEARCH FOUNDATION  
3115 MERRYFIELD ROW  
SUITE 200  
SAN DIEGO, CA 92121

## FILING RECEIPT



\*OC000000007159697\*

Date Mailed: 12/05/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

## Applicant(s)

Scott A. Lesley, San Diego, CA;  
Mark Knuth, El Cajon, CA;

## Assignment For Published Patent Application

IRM LLC;

## Domestic Priority data as claimed by applicant

THIS APPLN CLAIMS BENEFIT OF 60/324,833 09/24/2001.

*This appl. also claims ~~priority~~  
benefit of US Appl. No. 09/721,340,  
filed 11/21/00.*

## Foreign Applications

If Required, Foreign Filing License Granted 12/05/2001

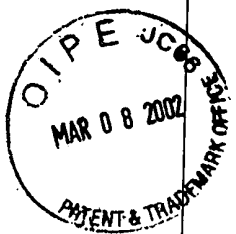
Projected Publication Date: To Be Determined - pending completion of Missing Parts

Non-Publication Request: No

Early Publication Request: No

## Title

Solubility reporter gene constructs



PATENT  
Attorney Docket No.: P0012US20

I hereby certify that this is being deposited  
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date indicated below, addressed to:

US Patent and Trademark Office, Box MISSING  
PARTS  
PO Box 2327  
Arlington VA 22202

# 8

Mailing Date: March 5, 2002

By: Ofelia Rosado  
Ofelia Rosado

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Scott A. LESLEY et al.

Application No.: 09/990,099

Filed: November 21, 2001

For: SOLUBILITY REPORTER GENE  
CONSTRUCTS

Art Unit: 1645

Examiner: not yet assigned

**PRELIMINARY AMENDMENT**

and

**REQUEST FOR CORRECTION OF  
FILING RECEIPT**

Box MISSING PARTS  
US Patent and Trademark Office  
Arlington VA 22202

Sir:

This is submitted in response to the Notice to File Missing Parts dated December 5, 2001. A petition to extend the time for response for one month, from February 5, 2002 to and including March 5, 2002, is enclosed.

**Preliminary Amendment**

Please delete pages 1-9 of the originally filed paper copy of the Sequence Listing and replace with the encloses substitute pages 1-14. A computer readable form (CRF) of the enclosed sequence listing was submitted electronically on March 5, 2002 (copy of Acknowledgement Receipt is attached). This CRF was prepared using PatentIn v. 3.1. The information recorded in computer readable form is identical to that contained in the enclosed

substitute paper copy of the sequence listing. Moreover, the enclosed substitute paper version of the sequence listing introduces no new matter into the application as originally filed. The substitute sequence listing is identical to the paper copy of the sequence listing that was originally filed with the application, except that the serial number and filing date is provided in the substitute sequence listing, as are the serial numbers and filing dates of the parent applications. The difference in the number of pages is due to changes in line spacing.

**Request for Correction of Filing Receipt**

Applicants respectfully request correction of an error that appears on the Filing Receipt. Specifically, the Filing Receipt does not list Applicants' claim to the November 21, 2000 priority date of US Application No. 09/721,340. This priority claim appears on the Application Data Sheet that was included with the application as originally filed, and also appears in the first page of the specification. Prior to filing the instant application, Applicants submitted a petition to convert Application No. 09/721,340 to a provisional application. Applicants have not yet been notified as to whether the petition has been granted. A copy of the Filing Receipt showing the requested change is enclosed.

**Response to Notice to File Missing Parts**

Applicants enclose herewith a copy of the Notice to File Missing Parts, an executed Declaration, and authorization to charge the surcharge for late filing of the Declaration to Deposit Account No. 50-1885.

CONCLUSION

In view of the foregoing, Applicant believes that this application is now in condition for examination. If a telephone conference would expedite prosecution of this application, please telephone the undersigned attorney at 858-812-1547.

Respectfully submitted,

*Timothy L. Smith*

Timothy L. Smith, Ph.D.  
Reg. No. 35,367

GENOMICS INSTITUTE OF THE NOVARTIS RESEARCH FOUNDATION  
10675 John Jay Hopkins Drive, Suite E225  
San Diego, CA 92121  
Tel: (858) 812-1547  
Fax: (858) 812-1570

Acknowledgment Receipt:

SUBMISSION TYPE: BIO Sequence Filing  
APPLICATION NUMBER: 09990099  
FIRST NAMED INVENTOR: Scott LESLEY  
TITLE OF INVENTION: SOLUBILITY REPORTER GENE CONSTRUCTS  
ATTORNEY DOCKET NUMBER: P0012US20



FILE LISTING:

|                              |                                |
|------------------------------|--------------------------------|
| transmittal                  | tranP0012US20.xml 6752 Bytes   |
| sequence-listing             | p0012US20.ST25.txt 15407 Bytes |
| biotechnology-listing-filing | P0012US20bio.xml 997 Bytes     |
| biotechnology-listing-filing | u-bio.dtd 3619 Bytes           |
| biotechnology-listing-filing | e-bioseq.xml 6067 Bytes        |

EFS ID: 14106

FILE SIZE: 19003 Bytes

TIMESTAMP: Tue Mar 05 12:30:02 EST 2002

MESSAGE DIGEST: mx9Ua3grj8qcFT7IkG72Nw==

DIGITAL CERTIFICATE HOLDER NAME: cn=Timothy L. Smith., ou=Registered Attorneys

UPLOAD STATUS: You have successfully uploaded your submission to USPTO

# FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$ 2214

## Complete if Known

Application Number 09/990,099  
Filing Date November 21, 2001  
First Named Inventor Scott A. LESLEY  
Examiner Name  
Group / Art Unit 1645  
Attorney Docket No. P0012US20

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account:

Deposit Account Number 50-1885

Deposit Account Name GENOMICS INSTITUTE OF THE NOVARTIS RESEARCH FOUNDATION

The Commissioner is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments  
☐ Charge any additional fee(s) during the pendency of this application  
☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

| Large Fee Code | Entity (\$) | Small Fee Code | Entity (\$) | Fee Description        | Fee Paid |
|----------------|-------------|----------------|-------------|------------------------|----------|
| 101            | 740         | 201            | 370         | Utility filing fee     | 740      |
| 106            | 330         | 206            | 165         | Design filing fee      |          |
| 107            | 510         | 207            | 255         | Plant filing fee       |          |
| 108            | 740         | 208            | 370         | Reissue filing fee     |          |
| 114            | 160         | 214            | 80          | Provisional filing fee |          |
| SUBTOTAL (1)   |             |                |             |                        | (\$ 740) |

### 2. EXTRA CLAIM FEES

|                    |    |        |   |    |   |                |    |     |          |      |
|--------------------|----|--------|---|----|---|----------------|----|-----|----------|------|
| Total Claims       | 76 | -20 ** | = | 56 | X | Fee from below | 18 | =   | Fee Paid | 1008 |
| Independent Claims | 7  | -3 **  | = | 4  | X | 84             | =  | 336 |          |      |
| Multiple Dependent |    |        |   |    | X |                | =  | 0   |          |      |

| Large Fee Code | Entity (\$) | Small Fee Code | Entity (\$) | Fee Description  |
|----------------|-------------|----------------|-------------|--|
| 103            | 18          | 203            | 9           | Claims in excess of 20                                     |
| 102            | 84          | 202            | 42          | Independent claims in excess of 3                          |
| 104            | 280         | 204            | 140         | Multiple dependent claim, if not paid                      |
| 109            | 84          | 209            | 42          | ** Reissue independent claims over original patent         |
| 110            | 18          | 210            | 9           | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$ 1344

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

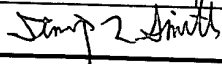
| Fee Code | Large Entity Fee (\$) | Fee Code | Small Entity Fee (\$) | Fee Description  | Fee Paid |
|----------|-----------------------|----------|-----------------------|--|----------|
| 105      | 130                   | 205      | 65                    | Surcharge - late filing fee or oath  | 130      |
| 127      | 50                    | 227      | 25                    | Surcharge - late provisional filing fee or cover sheet.                    |          |
| 139      | 130                   | 139      | 130                   | Non-English specification  |          |
| 147      | 2,520                 | 147      | 2,520                 | For filing a request for reexamination                                     |          |
| 112      | 920*                  | 112      | 920*                  | Requesting publication of SIR prior to Examiner action                     |          |
| 113      | 1,840*                | 113      | 1,840*                | Requesting publication of SIR after Examiner action                        |          |
| 115      | 110                   | 215      | 55                    | Extension for reply within first month                                     |          |
| 116      | 400                   | 216      | 200                   | Extension for reply within second month                                    |          |
| 117      | 920                   | 217      | 460                   | Extension for reply within third month                                     |          |
| 118      | 1,440                 | 218      | 720                   | Extension for reply within fourth month                                    |          |
| 128      | 1,960                 | 228      | 980                   | Extension for reply within fifth month                                     |          |
| 119      | 320                   | 219      | 160                   | Notice of Appeal   |          |
| 120      | 320                   | 220      | 160                   | Filing a brief in support of an appeal                                     |          |
| 121      | 280                   | 221      | 140                   | Request for oral hearing   |          |
| 138      | 1,510                 | 138      | 1,510                 | Petition to institute a public use proceeding                              |          |
| 140      | 110                   | 240      | 55                    | Petition to revive - unavoidable   |          |
| 141      | 1,280                 | 241      | 640                   | Petition to revive - unintentional   |          |
| 142      | 1,280                 | 242      | 640                   | Utility issue fee (or reissue)   |          |
| 143      | 460                   | 243      | 230                   | Design issue fee   |          |
| 144      | 620                   | 244      | 310                   | Plant issue fee  |          |
| 122      | 130                   | 122      | 130                   | Petitions to the Commissioner  |          |
| 123      | 50                    | 123      | 50                    | Processing fee under 37 CFR 1.17 (q)                                       |          |
| 126      | 180                   | 126      | 180                   | Submission of Information Disclosure Stmt                                  |          |
| 581      | 40                    | 581      | 40                    | Recording each patent assignment per property (times number of properties) |          |
| 146      | 740                   | 246      | 370                   | Filing a submission after final rejection (37 CFR § 1.129(a))              |          |
| 149      | 740                   | 249      | 370                   | For each additional invention to be examined (37 CFR § 1.129(b))           |          |
| 179      | 740                   | 279      | 370                   | Request for Continued Examination (RCE)                                    |          |
| 169      | 900                   | 169      | 900                   | Request for expedited examination of a design application                  |          |

Other fee (specify) \_\_\_\_\_

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 130

## SUBMITTED BY

|                   |   |                                  |               |           |              |
|-------------------|---|----------------------------------|---------------|-----------|--------------|
| Name (Print/Type) | Timothy L. Smith  | Registration No. Attorney/Agent) | 35,367        | Telephone | 858-812-1547 |
| Signature         |  | Date                             | March 5, 2002 |           |              |

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.



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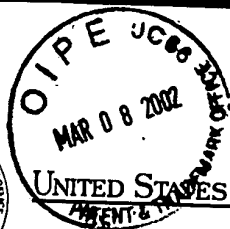
Approved for use through 10/31/2002. OMB 0651-0031  
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

|  |                             |                               |           |
|--|-----------------------------|-------------------------------|-----------|
| <b>TRANSMITTAL FORM</b><br><i>(to be used for all correspondence after initial filing)</i> | <b>Application Number</b>   | 09/990,099                    |           |
|  | <b>Filing Date</b>          | November 21, 2001             |           |
|  | <b>First Named Inventor</b> | Scott A. LESLEY               |           |
|  | <b>Group Art Unit</b>       | 1645                          |           |
|  | <b>Examiner Name</b>        |                               |           |
| <b>Total Number of Pages in This Submission</b>  | 27                          | <b>Attorney Docket Number</b> | P0012US20 |

| ENCLOSURES (check all that apply)  |   |  |
|--|---|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form<br><br><input type="checkbox"/> Fee Attached<br><br><input type="checkbox"/> Amendment / Response<br><br><input type="checkbox"/> After Final<br><br><input type="checkbox"/> Affidavits/declaration(s)<br><br><input type="checkbox"/> Extension of Time Request<br><br><input type="checkbox"/> Express Abandonment Request<br><br><input type="checkbox"/> Information Disclosure Statement<br><br><br><input type="checkbox"/> Certified Copy of Priority Document(s)<br><input checked="" type="checkbox"/> Response to Missing Parts/ Incomplete Application<br><input checked="" type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Assignment Papers (for an Application)<br><br><input type="checkbox"/> Drawing(s)<br><br><input type="checkbox"/> Licensing-related Papers<br><br><input type="checkbox"/> Petition<br><br><input type="checkbox"/> Petition to Convert to a Provisional Application<br><br><input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address<br><br><input type="checkbox"/> Terminal Disclaimer<br><br><input type="checkbox"/> Request for Refund<br><br><br><input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Group<br><br><input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences<br><br><input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)<br><br><input type="checkbox"/> Proprietary Information<br><br><input type="checkbox"/> Status Letter<br><br><input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):<br><br>Executed Declaration<br>Copy of Notice to File Missing Parts<br>Copy of filing receipt with requested changes<br>Preliminary Amendment and Request for correction of filing receipt<br>Paper Copy of Sequence Listing (14 pp) |
| <b>Remarks</b>   |   |  |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT |                                   |
|--|-----------------------------------|
| Firm or Individual name                    | Timothy L. Smith, Reg. No. 35,367 |
| Signature                                  | <i>Timothy L. Smith</i>           |
| Date                                       | March 5, 2002                     |

| CERTIFICATE OF MAILING   |                      |      |               |
|--|----------------------|------|---------------|
| I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: US Patent and Trademark Office, PO Box 2327, Arlington VA 22202 on this date: <u>March 5, 2002</u> |                      |      |               |
| Typed or printed name  | Ofelia Rosado        |      |               |
| Signature  | <i>Ofelia Rosado</i> | Date | March 5, 2002 |



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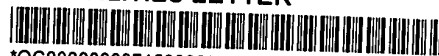
| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|--------------------|---------------------|-----------------------|------------------------|
| 09/990,099         | 11/21/2001          | Scott A. Lesley       | P0012US20              |

29490  
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OF THE NOVARTIS RESEARCH FOUNDATION  
3115 MERRYFIELD ROW  
SUITE 200  
SAN DIEGO, CA 92121

CONFIRMATION NO. 1291

## FORMALITIES LETTER

#7



\*OC000000007159698\*

Date Mailed: 12/05/2001

## NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

## Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The statutory basic filing fee is missing.

*Applicant must submit \$ 740 to complete the basic filing fee for a non-small entity. If appropriate, applicant may make a written assertion of entitlement to small entity status and pay the small entity filing fee (37 CFR 1.27).*

- Total additional claim fee(s) for this application is \$1344.

- \$1008 for 56 total claims over 20.

- \$336 for 4 independent claims over 3.

|            |          |          |         |          |
|------------|----------|----------|---------|----------|
| 03/13/2002 | BNGUYEN1 | 00000065 | 501005  | 09990099 |
| 01 FC:101  |          |          | 740.00  | CH       |
| 02 FC:103  |          |          | 1008.00 | CH       |
| 03 FC:102  |          |          | 336.00  | CH       |
| 04 FC:105  |          |          | 130.00  | CH       |

- The oath or declaration is unsigned.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(l) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.
- The balance due by applicant is \$ 2214.**

- This application does not contain a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). Applicant must provide such statement. If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000).
- A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the



sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

For questions regarding compliance to these requirements, please contact:

- For Rules Interpretation, call (703) 308-4216
- To Purchase PatentIn Software, call (703) 306-2600
- For PatentIn Software Program Help, call (703) 306-4119 or e-mail at [patin21help@uspto.gov](mailto:patin21help@uspto.gov) or [patin3help@uspto.gov](mailto:patin3help@uspto.gov)

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Initial Patent Examination Division (703) 308-1202

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